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09/750,105	12/29/2000	James M. Rogers	20009.0050US01 (BS00-139)	6282

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EXAMINER	
GRAHAM, PAUL J	
ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/750,105	ROGERS ET AL.	
	Examiner	Art Unit	
	PAUL J. GRAHAM	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4/2/08*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,7-11 and 21* is/are pending in the application.

4a) Of the above claim(s) *21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 7-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant argues:

2. *Knee fails to describe comparing the sets of values for ad 1 and ad 2 together.*

The Examiner respectfully disagrees. Reading the claims in the broadest sense, Knee does teach comparing the sets of values for ad 1 and ad 2 together.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988, F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993). In fact, Knee does compare the assigned values of ad 1 and ad 2 together. Knee's methodology makes use of the well known mathematical principle of transitivity, that is, Knee at least compares the values of ad 1 to a benchmark (e.g. a profile) and then compares the values of ad 2 to a benchmark and the benchmark being the same set of values for the comparisons allows the user of transitivity to compare the values of ad 1 and the values of ad 2 together. So, if ad 1 =A and ad 2 = C and the benchmark = B, then if A > B and B > C, then A > C. The rejection is further supported with the use of Ficco (US 2005/0166224 A1). The applicant's arguments have been fully considered, but are not persuasive. Claims 1-3, and 7-11 stand rejected.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 7 recites ***"…the television program"*** and as currently limited claim 7 nor claim 1 do not contain antecedent basis for such language.

Amended claim 7 recites the scheduling data of a television program (i.e., "the time and day of the week") and the type of television program. However, it is unclear from the instant specification how categorization of television programs are possible and time of day of the week of program is possible given minimal mention of program scheduling such as an EPG and little to no mention of program categories.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1-3 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US Pat No. 6,698,020) in view of Knee et al. (US Pub No. 2002/0095676 A1) in view of Ficco (US 2005/0166224 A1).

Regarding claim 1, Zigmond et al. discloses a "method for inserting targeted advertisements into a media delivery stream during broadcast media program" using the apparatus of Figure 3. As illustrated in Figure 5, the method comprises "storing data files representing a plurality of advertisement in a media delivery device" [80] in a "database" [86] or organized data structure containing a number of records in the form of advertisements wherein the "stored advertisements are each of a type that is determined to appeal to one or more users of the media delivery device" (Col 12, Lines 15-24; Col 13, Lines 7-12). The apparatus "receives a signal in the media delivery device" associated with the vertical blanking interval "to insert a stored advertisement into the media delivery stream during broadcast media programming wherein the signal to insert the stored advertisement is

sent with the broadcast media programming" (Col 15, Lines 35-65). The 'signal' associated with the vertical blanking interval also "includes at least one classification of the plurality of classifications" for selecting a commercial stored in the database for insertion into the media delivery stream (Col 11, Lines 31-49; Col 11, Line 66 – Col 12, Line 32; Col 16, Lines 43-56). The apparatus "searches . . . for the stored advertisement having the at least one classification that is provided in the signal" and "inserts [the selected] advertisement stored in the database into the media delivery stream" (Col 15, Lines 56-65). Subsequently, the system "transmits a request from the media delivery device to an external network through a telecommunications link to receive the plurality of advertisements for storage in the media delivery device" (Col 15, Lines 2-16).

In selecting an advertisement for insertion, the Zigmond et al. reference contemplates that a "search by classification [may] produce more than one stored advertisement" whereupon the system selects one advertisement for insertion (Col 16, Line 65 – Col 17, Line 9). Part of the selection criteria may include demographic information (Col 14, Lines 34-48). Zigmond et al., however, is unclear with respect to the particular usage of 'weighting' in selecting between multiple advertisements that match a given category.

In an analogous art pertaining to the problem of advertisement insertion, the Knee et al. reference discloses "creating a record in a data table associated with each of [a] plurality of advertisements [wherein] the data table includes a plurality of classifications [or demographic categories] for each of the plurality of advertisements" and "assigning a weighting to at least two classifications for each of the plurality of advertisements" (Figure 2). Subsequently, the system "searches the data table . . . [and] if the search by classification produces more than one stored advertisement, then selecting the stored advertisement to be inserted by comparing each of the at least two classification weightings in the table for each of the stored advertisements that were produced by the search" ; (Para [0029] – [0034], [0046], [0047], and [0049], a data table made up of records). For example, even though both advertisements match being for 'sports fans' a closest match fit would result in the selection of advertisement #2. As evidenced by Knee et al., the technique of categorization 'weighting' for

selecting between advertisements that meet a desired classification in order to choose the best advertisement for display was part of the ordinary capabilities of a person of ordinary skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art to utilize the known technique with Zigmond et al. so as to refine its advertisement selection process using demographic information (Knee et al.: Para. [0007] - [0008]).

Knee does teach comparing the two advertisements together, at least via the well-known transitivity principles (see Knee, fig. 2 and [46-49] and p. 6, claim 14; Knee's methodology makes use of the well known mathematical principle of transitivity, that is, Knee at least compares the values of ad 1 to a benchmark (e.g. a profile) and then compares the values of ad 2 to a benchmark and the benchmark being the same set of values for the comparisons allows the user of transitivity to compare the values of ad 1 and the values of ad 2 together. So, if ad 1 =A and ad 2 = C and the benchmark = B, then if A > B and B > C, then A > C.); however, Knee is unclear about on-the-fly individualization of ads in comparing the sets together.

Ficco, who discloses broadcast advertisement adaptation, does also teach such comparison (see Ficco, [5, 10, 36]).

Therefore, in further support of the non-obvious status of the claims, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Zigmond and Knee with that of Ficco in order to individualize the process on the fly (see Ficco, [5, 10]).

Claim 2 is rejected wherein the "advertisements are television commercials" (Zigmond et al.: Col 1, Lines 14-22; Col 7, Lines 13-25).

Claim 3 is rejected wherein the "media delivery device is a set top box for receiving broadcast signals for a cable or satellite television network system" (Zigmond et al.: Col 7, Lines 1-12 and 37-51).

Claims 6 and 7 are rejected wherein the method further comprises the "creating and weighting a sub-classification for each classification" in accordance with the advertisement selection rules [83] (i.e. a given rule specifying a particular criterion defines an absolute weight) (Zigmond et al.: Col 11, Lines

31-49) wherein the "sub-classifications include at least two of: a frequency by which each resulting commercial has been inserted [and] a correlation between a product being advertised and the type of a television program" (Zigmond et al.: Col 12, Lines 60 – Col 13, Line 6; Col 13, Line 40-47, the identity of advertiser is part of comparison of income for targeting (Knee [32]), types of broadcasts and time of day of program are attainable through use of program guide (see Knee, fig. 1, 3,4)).

Claim 8 is rejected wherein the "plurality of stored advertisements are received by the media delivery device as encoded data files through the telecommunications link to an external database of advertisements" (Zigmond et al.: Col 14, Line 66 – Col 15, Line 17; Col 15, Lines 24-34).

Claim 9 is rejected wherein the method further comprises "transmitting signals between the media delivery device and the external network indicating the one or more types of advertisements that appeal to users of the media delivery device" (Zigmond et al.: Col 9, Lines 21-38) and "classifying the stored advertisements according to a plurality of categories, which includes a classification according to the type of advertisement that is stored" (Zigmond et al.: Col 11, Lines 37-42; Col 12, Lines 26-33).

Claim 10 is rejected wherein "after transmitting the request, receiving download signals from the broadcast media stream in the media deliver device to download the data files representing the advertisements for storage in the media delivery device, wherein for each advertisement the signals include a classification as provided in the table for selecting an advertisement stored in the database for insertion into the media delivery stream" (Zigmond et al.: Col 12, Lines 26-33; Col 14, Line 66 – Col 15, Line 16) and "downloading the data files representing the advertisements having a classification as provided in the table that matches a pre-stored classification in a list of classification indicating the one or more types of advertisements that appeal to users of the media delivery device" (Zigmond et al.: Col 14, Lines 24-27; Col 15, Lines 17-23).

Regarding claim 11, the combined references are unclear with respect to the 'demographic information' of Knee further including a category for location of sponsor' type of product advertised". Zigmond et al. discloses targeting advertisements based on location (Zigmond et al.: Col 14, Lines 48-53). The examiner takes OFFICIAL NOTICE that location information as a demographic classifier

is notoriously well known in the art. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined references such that the "weighted classifications in the table include . . . location of sponsor" for the purpose effectively targeting advertisements to those most likely interested in the products or services they offer (Knee et al.: Para. [0007]). For example, a west coast chain of automobile dealerships would not likely be patronized by a east coast resident. Therefore, an advertisement for that west coast dealership would not be as effective on the east coast.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL J. GRAHAM whose telephone number is (571)270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pjg
7/12/08

/Vivek Srivastava/
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